

Appl. No. 09/867,642

Amdt. dated February 1, 2005

Reply to Office action of November 30, 2004

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

The specification has been amended by correcting a typographical error on page 10.

Claims 1-5 remain in the application. Claim 1 has been amended. More specifically, we have emphasized the "standalone" nature of the simulator in claim 1. Throughout the specification, applicants explained that the novelty of the invention resides in the standalone nature of the simulator which can be downloaded and executed on the user's computer without the requirement that the computer be connected to the Internet or other network.

On page 2 of the detailed action, the Examiner rejected the claims under 35 U.S.C. § 112, first paragraph, as not being enabled by the specification. According to the Examiner, the specification lacks enabling detail and the specification "appears to merely disclose generalities." We respectfully disagree. While it is true that the specification describes much of the subject matter on a conceptual level, there is provided sufficient detail to enable one of skill in the pertinent art to make and use the invention.

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Those of ordinary skill in the art know simulators. They know how to make a simulator and they know how to program a simulator. As described in the specification, computerized simulators for integrated circuits or other electronic circuits are well known in the art. A certain amount of assembly work will, of course, be required and it may even take a certain amount of experimentation before the standalone simulator that is tagged to the specific electronic component may be ready for distribution. The dispositive issue, however, is that making and/or using the invention will not require "undue" experimentation.

The Examiner's statement according to which there is no enabling detail in the specification that relates to the on-line catalog is simply not understood. The term "catalog" as used herein is an index-related database with a minimum of two columns that links individual components to individual standalone simulators (executable program content). An on-line catalog is thus a simple listing of items and typically hyperlinked buttons or text that is clickable by the user as it appears on the user's screen.

The Examiner is requested to reconsider the rejection under 35 U.S.C. § 112, first paragraph. The claimed invention is indeed described with sufficient detail so as to enable one of skill

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in the art to make and/or use the invention without undue experimentation.

We now turn to the art rejection and, first, to the rejection of claims 1-5 over Ishigami et al. under 35 U.S.C. § 102(a).

We respectfully traverse.

The instant application has a filing date of May 30, 2001. It is thus not understood what effect it would have for Ishigami to disclose something that was known "as of at least 12/27/2001." If it was known in December of 2001, it certainly would have no bearing on an application that was filed in May of 2001. Furthermore, the Examiner points to In re Epstein, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994). The "hearsay rule" of Epstein is clearly not applicable in the instant case. Besides the fact that the dates are entirely wrong, there is no indication that what is purported to have been known was known in this country. The explicit words of 35 U.S.C. § 102(a), of course, require that the prior use and knowledge were in this country. As a matter of fact, the Ishigami disclosure points to Japan as the country of origin.

In view of the foregoing, the Examiner is requested to withdraw the rejection over Ishigami et al..

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We now turn to the rejection of claims 1-5 as being anticipated by Beall et al. (US 6,169,992 B1 "Beall") or McDonald et al. (US 6,530,065 B1 "McDonald") under 35 U.S.C. § 102(e). We respectfully traverse.

As noted above, the instantly claimed invention deals with standalone simulators and with their adaptation to a specific electronic component. Claim 1 of the instant application calls for a method in which a computer-executable file with a standalone simulator is stored and offered for download and in which the consumer is enabled to execute a simulation in standalone mode. Claim 4 deals with a product support system in which standalone simulators are stored, offered for download and enabled for execution in standalone mode as a standalone simulator.

The invention recited in claims 1 and 4 is not anticipated by the prior art. Beall and McDonald deal with on-line simulators and catalogs. Specifically, Beall allows an applet to be downloaded and executed within the user's web browser. The necessary data for display and processing in the applet is provided by the on-line server. As a matter of fact, Beall describes a system where a part may have "additional information associated with it on the World Wide Web." Col. 15, lines 57-58. When the user clicks on a specific link, an

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HTML document may be accessed or an applet may be downloaded with executable content. Beall provides an example, namely, "a circuit simulation applet to model the selected integrated circuit's performance." Col. 15, line 66, to col. 16, line 1. Beall goes on to explain that the user may browse the necessary information and choose from additional information.

Any of these associated URLs might also be Java applets, whose launch results in execution of the applet locally within the user's web browser 4014. For example, an output voltage attribute might have an associated HTML page containing an applet that interacts with the user, accepting various input parameters and dynamically graphing the resulting voltage or current curves representing device characteristics. This allows for interactive functionality associated with any database element to be delivered to the user on demand.

Beall, col. 16, lines 12-21.

It is entirely clear that Beall's user remains connected to the server at all times during the execution of the applet. The applet within the web browser requires additional input that is retrieved in an interactive sense from the server. In this regard, Beall's example is not different from the Transim system that is described in the last paragraph of page 3 of the specification.

The reference McDonald indeed represents the Transim system. Again, McDonald describes an on-line system where the user is required to remain connected (or reconnect several times during the process as is typical in such executable applets)

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to the web server. In the preferred embodiment, of course, the web server is available through the world wide web.

The Examiner points to col. 8, lines 20-64 of McDonald. In that text, the very issue is clearly explained, namely that the client-side applet is run on the client computer 150 and that the primary simulation is performed at the server side. This is further underscored by stating that "[t]he applet creates a tcp/ip socket to the server 100 for messaging and communication." Col. 8, lines 47-48. The TCP/IP socket, of course, is required in order to continue the on-line session.

Claim 1 with its standalone simulation and claim 4 with its standalone simulator are not anticipated by the prior art of record.

The Examiner is respectfully urged to withdraw the rejection over Beall and the rejection over McDonald.

None of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 and 4. These claims are, therefore, patentable over the art and since all of the dependent claims are ultimately dependent thereon, they are to be patentable as well.

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In view of the foregoing, reconsideration and allowance of
claims 1-5 are solicited.

Respectfully submitted,



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